

Remarks/Arguments

Applicant acknowledges with appreciation the Examiner's indication that Claims 8 and 10 contain allowable subject matter and would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims.

By way of the present amendment, Applicant provides herein amendments to the Specification to correct inadvertent typographical errors and to update an application's status to issued patent. No new matter has been added by way of these amendments. Applicant has also amended Claims 1, 10, 11, 15 and 16; canceled Claims 4-9; and added new Claims 21-25. Nineteen (19) claims remain pending in the application: Claims 1-3 and 10-25 of which Claims 1, 10, 11, 16, 22 and 24 are independent. Applicant respectfully requests reconsideration of the pending claims, in view of the amendments above and comments below.

Claim Rejections - 35 U.S.C. § 112

The Examiner indicated that in Claim 15, the limitation "externally-generated signals" had insufficient antecedent basis. Applicant has amended Claim 15 to correct the antecedent basis of this limitation. Thus, this rejection should be removed.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected Claims 1, 4-7, 9, 11-15 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Markowitz et al. U.S. Patent No. 5,626,630 (the Markowitz '630 patent) in view of Adams U.S. Patent No. 5,383,915 (the Adams '915 patent).

The Examiner rejected Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over the Markowitz '630 patent in view of the Adams '915 patent and further in view of Schulman et al. U.S. Patent No. 6,603,726 (the Schulman '726 patent).

The Examiner rejected Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over the Markowitz '630 patent in view of the Adams '915 patent and further in view of Stover et al. U.S. Patent No. 6,804,561 (the Stover '561 patent).

The Examiner further rejected Claims 12-14 and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over the Markowitz '630 patent in view of the Adams '915 patent and further in view of the Schulman '726 patent and the Stover '561 patent.

The Claims have been amended as follows:

- Independent Claim 1 has been amended to include the subject matter of original Claims 4-7 and the allowable subject matter found in original Claim 8, which claims have been canceled.
- Claim 9 has been canceled.
- Claim 10 was indicated by the examiner as containing allowable subject matter and has been rewritten in independent from including all of the limitations of the base claim and intervening claims.
- Independent Claim 11 has been amended to include a limitation found in original Claim 7 and the allowable subject matter found in original Claim 10.
- Independent Claim 16 has been amended to include a limitation found in original Claim 7 and the allowable subject matter found in original Claim 10.

Because the allowable subject matter from original Claims 8 and 10 is now found in amended Claims 1 and 10, it is submitted that Claims 1 and 10, and those claims that depend therefrom, should be patentable for, *inter alia*, at least the same reasons that original claims 8 and 10 were found by the Examiner to contain allowable subject matter.

Regarding the rejection of Claims 11 and 16, Applicant submits that these independent Claims now include, *inter alia*, a limitation which is not found, taught, or suggested by the Markowitz '630 patent alone or in combination with the Adams '915 patent. The implantable neural stimulator system as presented in Claims 11 and 16 now includes the limitation:

holding means for temporarily holding the repeater and the first coil in alignment with the implantable unit, wherein the holding means comprises a housing having a magnet therein, and wherein the magnet is adapted to magnetically engage with a magnetic member of the implantable unit and to thereby hold the housing in place over the implantable unit.

This limitation is not found, taught or suggested by the Markowitz '630 patent alone or in combination with the Adams '915 patent. Thus, it is respectfully submitted that Applicant's claimed invention, as presented in Claims 11 and 16, would not have been obvious at the time the invention was made to a person having ordinary skill in the art because it fails to show or suggest this limitation, and this deficiency is not supplied by the primary reference, the Markowitz '630 patent, nor the secondary reference, the Adams '915 patent. The added limitation is also found in original Claims 7 and 10, and Claim 10 was indicated by the Examiner to contain allowable subject matter. Hence, it is respectfully submitted that a *prima facie* case of obviousness has not been established by the Markowitz et al. reference or the combined references of Markowitz et al. and Adams. Applicant submits that amended Claims 11 and 16 are thus allowable as well as the dependent claims that depend therefrom.

Newly Added Claims

By way of the present amendment, five new claims have been added. No new matter has been added by way of these amendments. New independent Claims 22 and 24 parallel original Claims 11 and 16 respectively and include, *inter alia*, a limitation from original Claim 7 and the allowable subject matter from original Claim 8. Thus, new independent Claims 22 and 24 and those that depend therefrom should be allowable.

Conclusion

In view of the foregoing, it is respectfully submitted that the rejections have been overcome and that the pending claims are in condition for allowance. An indication of allowability of Claims 1-3 and 10-25 at an early date is thus earnestly solicited.

The Examiner is invited to telephone the undersigned, Victoria A. Poissant, should any issues remain after consideration and entry of this response, in order to permit early resolution of such issues.

Respectfully Submitted,

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